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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,530	08/07/2001	Lawrence D. Bergman	YOR920000742US1	2121

7590 11/30/2004
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560

EXAMINER	
TO, BAOQUOC N	
ART UNIT	PAPER NUMBER

2162

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,530

Applicant(s)

BERGMAN ET AL.

Examiner

Baoquoc N To

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-49 are pending in this application.

Response to Amendment

2. The DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 filed on 06/28/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Acharya reference.

The DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 attempts to show conception of the invention prior to the effective date of the reference 03/23/2001 coupled with due diligence from prior to the reference data to the filing date 08/07/2004 of the application (constructive reduction to practice).

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Acharya reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

I. Conception

- A) A conception of an invention, through evidenced by disclosure, drawing, and even a model, is not a complete invention under the patent laws, and confers no rights on inventor, and has no effect on a subsequently granted

patent to another, UNLESS THE INVENTORS FOLLOWS IT WITH
REASONABLE DILIGENCE BY SOME OTHER ACT.

B) General allegation that the invention was completed prior to the data of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23.23 O.G. 1224 (Comm'r Pat. 183). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

C) The affidavit or declaration and exhibits must clearly explain which facts or data application is relying on to show completion of his or her invention prior to the particular date.

D. When reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." However, in the affidavits the applicant recited "Indexing Method For Queries Using Multiple Positive and Negative examples" which only indicated a vague idea of conception is made on October 30, 2000. The requirement for the conception is more than a vague idea of how to show the problem; the means themselves and their interaction must be comprehended also. The applicant also must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by application. The statement which recited in paragraph 2 and 3 are general allegation that the invention

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was complete prior to the date of the reference 03/23/2001 without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

II. Diligence

A. In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

B. The critical period in which diligence must be shown begins just prior to the effective date of the reference 03/23/2001 or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).

C. The conception occurs prior to the date of the reference, but reduction to practice afterward, it is not enough merely to allege that applicant or patent owner had been diligent. The exhibit(s) which was demonstrated by the application was not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the filing date 08/07/2001 in determining the sufficiency of 37 CFR 1.131, the critical period in which diligence must be shown begin just prior to the effective date of the reference 03/23/2001 or activity ends with the date of a reduction to practice, either actual or constructive.

III. Claims or Claims limitation is not comprehended by the exhibits.

A. Exhibit does not explicitly indicate the retrieval of the multidimensional data which recited in the preamble of claims 1 and 9 and multidimensional indexing engine recited in the limitation of claim 5, wherein the exhibit only suggests:

“Indexing

The class of indexing structures to which the invention applies are based on recursive partitioning of the search space in such a way that each recursive step refines the current partition.

Such class method include:

- The R-Tree and almost all the derived structures;
- The KR-Tree and almost all the derived structures;
- The Quadtree and almost all the derived indexing structures;”

C. The exhibits does not explicitly indicate on “the transformed said database based on said user input to generate a transformed database; and successively searching said transformed database to retrieve data.” The exhibit only suggests “the process modifying the database using the queries” which has different in the understanding from the “transformed database based on said user input” from the recited claims 1 and 9. The “modified database” and the “transformed database” has different meaning. For example, “modifying database” mean content of the database has changed; however, “transformed data” means translates from one format to another format which does not change its content. Therefore the suggested “modified database using the queries” which cannot be comprehended as “transformed database.”

Therefore, the DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. 1.131 filed on 06/28/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Acharya reference, based on the three reasons:

A. The affidavit or declaration and exhibits must clearly explain which facts or data application is relying on to show completion of his or her invention prior to the particular date. The conception is more than of how to show the problem; the means themselves and their interaction must be comprehended also. The applicant also must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by application. The statement which recited in paragraph 2 and 3 are general allegation that the invention was complete prior to the date of the reference 03/23/2001 without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

B. The conception occurs prior to the date of the reference, but reduction to practice afterward, it is not enough merely to allege that applicant or patent owner had been diligence. The exhibit(s) which was demonstrated by the application was not clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the filing date 08/07/2001 in determining the sufficiency of 37 CFR 1.131, the critical period in which diligence must be shown begin just prior to the effective date of the reference 03/23/2001 or activity ends with the date of a reduction to practice, either actual or constructive.

C. The exhibits must be comprehended to one ordinary skill in the art and concepts must support by accompanying with the claims.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is at 571-272-4041 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached at 571-272-4107.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231.

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The fax numbers for the organization where this application or proceeding is assigned are as follow:

(703) 872-9306 [Official Communication]

Hand-delivered responses should be brought to:

Crystal Park II
2121 Crystal Drive
Arlington, VA 22202
Fourth Floor (Receptionist).

Baoquoc N. To
Nov 16, 2004



JEAN M. CORRIELUS
PRIMARY EXAMINER